

**THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF  
THE TTAB**

Mailed: August 31, 2004  
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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re USF&G Corp.

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Serial No. 74716462

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Julie A. Matheson of Finnegan, Henderson, Farabow, Garrett  
& Dunner, L.L.P. for USF&G Corp.

Mary Rossman, Trademark Examining Attorney, Law Office 108  
(David Shallant, Managing Attorney).

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Before Quinn, Hairston and Drost, Administrative Trademark  
Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by USF&G Corp. to  
register the mark VISIONPAK for "insurance underwriting  
services for emerging technology companies in the field of  
property and casualty."<sup>1</sup>

Registration has been refused by the Trademark

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<sup>1</sup> Serial No. 74716462, filed August 16, 1995, which is based on  
an allegation of a bona fide intention to use the mark in  
commerce.

Examining Attorney pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the previously registered mark VISION for "underwriting insurance services,"<sup>2</sup> as to be likely to cause confusion, mistake or deception.

Applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

The Examining Attorney argues that VISION is the dominant portion of the marks and that applicant has merely added the less significant term PAK to registrant's mark. Further, it is the Examining Attorney's position that registrant's underwriting insurance services are broadly identified and thus encompass applicant's insurance underwriting services for emerging technology companies in the field of property and casualty.

Applicant, in urging reversal of the refusal to register, maintains that its services are highly specialized and thus are different from registrant's services. Also, applicant argues that "the Examining Attorney has impermissibly dissected [applicant's] unitary mark, and then [given] the common element 'VISION' a broad scope of protection, rather than the narrow scope properly

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<sup>2</sup> Registration No. 1,335,908 issued May 14, 1985; affidavits under Section 8 and 15 accepted and acknowledged, respectively.

afforded to a diluted term.” (Brief, p. 6). In this regard, applicant submitted copies of third-party registrations of marks consisting of or containing the word VISION. When the marks are viewed in their entirety, applicant maintains that its mark VISIONPAK is dissimilar to registrant’s mark VISION.

Our determination under Section 2(d) is based on an analysis of all the facts in evidence which are relevant to the factors bearing on the issue of likelihood of confusion. In re E. I. duPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services.

With respect to the services, it is well settled that the issue of likelihood of confusion must be determined on the basis of the services as they are set forth in the involved application and the cited registration and not in light of what such services are shown or asserted to actually be. Canadian Imperial Bank v. Wells Fargo Bank, N.A., 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987).

We find that registrant's underwriting insurance services encompass applicant's insurance underwriting services for emerging technology companies in the field of property and casualty. Applicant has limited the class of purchasers and the field of its insurance underwriting services to emerging technology companies in the field of property and casualty. However, the cited registration is broadly worded and contains no limitations as to class of purchasers or field. Therefore, we must presume that the services of registrant encompass all types of insurance underwriting services, including those in the field of property and casualty and that such services are sold to all of the normal purchasers for services of the type identified, which would include emerging technology companies. Thus, the limitation to applicant's recitation of services does not adequately distinguish its services from those of registrant. In short, for purposes of our likelihood of confusion analysis, the services of applicant and registrant are overlapping.

This brings us to a consideration of the marks. We begin with the premise that "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v.

Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Further, while marks must be considered in their entirety, "in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Moreover, the proper test for confusingly similarity is not whether the respective marks are distinguishable on the basis of a side-by-side comparison inasmuch as this is not ordinarily the way that customers will be exposed to the marks. Rather, it is the similarity of the general overall commercial impression engendered by the marks which must determine whether confusion as to source or sponsorship is likely.

In this case, both marks contain the same word VISION to which applicant adds the highly suggestive term PAK. This additional term does not significantly change the appearance, pronunciation, meaning or commercial impression. The term "pak" in applicant's mark suggests an insurance package consisting of several coverages. The

Examining Attorney submitted an excerpt from Webster's II New Riverside University Dictionary (1988) wherein "package" is defined, inter alia, as: "A proposition or offer consisting of several items each of which must be accepted - a vacation *package*."<sup>3</sup> Also, the Examining Attorney submitted copies of sixteen third-party registrations of marks which contain the term "PAK" (or "PAC") for insurance underwriting services.<sup>4</sup> These registrations serve to demonstrate that the term "PAK" has been frequently incorporated into marks for insurance underwriting services because of its suggestive significance. In view of this evidence, the term "PAK" in applicant's mark is, as the Examining Attorney states, highly suggestive of applicant's services. In this regard, we note the following statement from applicant's brochure:

USF&G'S VISIONPAK NOT ONLY TAKES CARE OF YOUR  
BASIC NEEDS BUT ALSO ADDS SPECIAL COVERAGES THAT  
MINIMIZE THE UNIQUE RISKS YOU FACE.

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<sup>3</sup> Additionally, we take judicial notice of the definition in Random House Webster's Unabridged Dictionary (2<sup>nd</sup> ed. 1999) of "pak" as "pack; package."

<sup>4</sup> Third-party registrations are not evidence that the marks therein are in use or that the public is familiar with them. See *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983). However, "third-party registrations are probative to the extent that they may show the meaning of a mark or a portion of a mark in the same way that dictionaries are employed." *Mead Johnson & Company v. Peter Eckes*, 195 USPQ 187, 191 (TTAB 1977).

Here, the highly suggestive term PAK in applicant's mark VISIONPAK, while not present in registrant's VISION mark, is insufficient to distinguish such marks due to the fact that the shared term VISION creates a high degree of similarity in sound, appearance, and connotation. Overall, the respective marks project the substantially same general commercial impression.

With respect to applicant's contention that the cited mark VISION is weak, the third-party registrations referenced by applicant are entitled to little weight on the question of likelihood of confusion. As previously indicated, third-party registrations are not evidence that the marks shown therein are in use or that the public is familiar with them. While, as noted, third-party registrations may be used to demonstrate that a portion of a mark is suggestive or descriptive, they cannot be used to justify the registration of another confusingly similar mark. See *In re J. M. Originals*, 6 USPQ2d 1393, 1394 (TTAB 1988). We note that only a handful of the registrations cover insurance underwriting services, and among these, most cover insurance underwriting services in the eye-care field. Each of the marks in these particular registrations creates a different commercial impression from registrant's mark. [For example, Registration No. 1,448,851 for the

mark DELTA VISION (VISION is disclaimed) covers underwriting insurance for prepaid vision care services].

However, even if the cited registrant's VISION mark is regarded as weak, it is still entitled to protection against the registration of a substantially similar mark for overlapping services. See, e.g., *Plus Products v. Physicians Formula Cosmetics, Inc.*, 198 USPQ 111, 114 (TTAB 1978) and *In re Textron Inc.*, 180 USPQ 341 (TTAB 1973), citing *Eastern Industries, Inc. v. Waterous Co.*, 289 F.2d 952, 129 USPQ 422, 424 (CCPA 1961).

While we recognize that the services involved herein would be purchased with a degree of care, this fact "does not necessarily preclude [purchasers] mistaking one trademark from another" or demonstrate that they otherwise would be entirely immune from confusion as to the source or sponsorship of the services. *Wincharger Corp. v. Rhino Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962).

In view of the foregoing, we conclude that persons who are familiar with registrant's VISION mark for underwriting insurance services would be likely to believe, upon encountering applicant's VISIONPAK mark for insurance underwriting services for emerging technology companies in the field of property and casualty, that such services emanate from or are sponsored by or associated with the



same source. Indeed, such persons may assume that VISIONPAK is a variant of the registrant's mark adapted to suggest an insurance package consisting of several coverages.

To the extent that we have any doubt as to this conclusion, we resolve such doubt, as we must, in favor of registrant. In re Hyper Shoppes (Ohio) Inc., 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

**Decision:** The refusal to register under Section 2(d) is affirmed.